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Xiao Zhang

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IBM CORPORATION, INTELLECTUAL PROPERTY LAW  
DEPT 917, BLDG. 006-1  
3605 HIGHWAY 52 NORTH  
ROCHESTER, MN 55901-7829

EXAMINER

DAGNEW, SABA

ART UNIT

PAPER NUMBER

3688

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/684,125	<b>Applicant(s)</b> ZHANG, XIAO	
	<b>Examiner</b> SABA DAGNEW	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 33-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 33-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Status of the Claims

1. It is noted that an **Appeal Brief** was filed on **September 29, 2008** and an **Examiner's Answer** was provided and mailed on December **5, 2008** in response to the Appeal Brief. A **new rejection** was provided in the Examiner's Answer under 35 U.S.C. 101. The applicant, thus, filed a request to reopen prosecution on February 5, 2009 in order to overcome the rejection under 35 U.S.C 101, as well as the rejections under 35 U.S.C 102(b) and 35 U.S.C 103(a).

The rejection under **35 U.S.C 101** has been **withdrawn**.

The rejection under **35 U.S.C 102(b) and 35 U.S.C 103(a)** have been **maintained**.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-15 and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Henson (6,167,383).

Claims 1, 5, and 9: Henson discloses a method for cross-selling products based on a system configuration, comprising:

- a. receiving an order (product selection) from a user (Figures 3a-3c; column 4, lines 41-47; and column 6, lines 18-43);
- b. determining if there are one or more cross-sells based on the ordered products and the state (configuration) of the system (column 10, lines 30-48);
- c. presenting the discounted cross-sells to the user based on the state (configuration) of the system (column 6, lines 39-43; column 7, lines 22-41; and column 9, line 40 – column 10, line 18); and
- d. calculating the price of the newly configured system (Figures 3a-3c).

The Examiner notes that the Applicant has defined “cross-sells” to include “cross-sell products may be offered at a discounted price (or be entirely free), but only when purchased along with another specific product.” (page 10, paragraph 0039). Henson explicitly discloses offering the user “McAfee VirusScan 3.1 at no additional charge” when the user has selected Microsoft Windows 95 or 98. (Figure 3a). Thus, Henson is offering a cross-sell “at a discount based on the state of the system”, but only when it “is determined to be compatible with the state of the system”, i.e. only when the user has selected Microsoft Windows 95 or 98.

Claim 2: Henson disclose a method as in Claim 1 above, and further discloses the order (products) has been processed to verify the validity (compatibility) of the system as it is received (column 10, lines 30-48).

Claims 3, 12, and 13: Henson discloses a method as in Claim 1 and 9 above, and further discloses that the individual products have been validated as they are received to ensure compatibility with the system so that the system can operate properly (Figures 3a-3c and column 7, line 57 – column 8, line 44).

Claims 4 and 11: Henson discloses a method as in Claims 1 and 9 above, and further discloses qualifying the order is based on predefined conditions (column 10, lines 30-48).

Claim 6: Henson discloses a method as in Claim 1 above, and further discloses receiving a selection of a cross-sell product from the user and adding that selected product to the system (Figures 3a-3c). The Examiner notes that the system has already determined that the cross-sell product is compatible with the system before offering the cross-sell to the customer (see Claim 1 above). Thus, it is inherent that the cross-sell product selected by the user is compatible. Nonetheless, Henson also discloses presenting a message to the user indicating when an incompatible product has been selected by the user (column 5, lines 1-2; column 6, lines 39-43; column 7, lines 22-38 and 57-61).

Claims 7 and 14: Henson discloses a method as in Claims 1 and 9 above, and further discloses presenting the cross-sell products via a graphical user interface (GUI) (column 6, lines 39-43; column 7, lines 22-41; and column 9, line 40 – column 10, line 18).

Claims 8, 10 and 15: Henson discloses a method as in Claims 7, 9, and 14 above, and further discloses a selectable graphical element that enables the user to add one or more of the cross-sell products to the system (Figures 3a-3c).

Claim 33: Henson discloses a method for cross-selling products based on a system configuration, comprising:

- a. receiving user selection of one or more components of a configured system (Figures 3a-3c; column 4, lines 41-47; and column 6, lines 18-43);
- b. determining, based on the selected components, one or more cross-sell products that may be added to (i.e. compatible with) the system (column 10, lines 30-48);
- c. determining a discounted value for each of the cross-sell products (inherent);
- d. providing to the user one or more indications (i.e. a list of the cross-sell product or products) along with the determined discount price (Figure 3a);
- e. receiving a user selection of a cross-sell product and adding it to the system (Figures 3a-3c); and
- f. presenting a message to the user indicating a valid or invalid selection (column 5, lines 1-2; column 6, lines 39-43; column 7, lines 22-38 and 57-61).

The Examiner notes that the claimed steps referencing “software wizards to assist the user in configuring the configured system” are the equivalent to the steps performed by Henson’s “configuration, pricing, validation, shipment delay indication, and merchandising modules” (column 6, lines 31-34), and are reiterations of the steps a-e above for each new component product selected by the user.

Claim 34: Henson discloses a method as in Claim 33 above, and further discloses applying matching logic to determine whether the component product satisfies predefined conditions. Henson explicitly discloses offering the user “McAfee VirusScan 3.1 at no additional charge” when the user has selected Microsoft Windows 95 or 98. (Figure 3a). Thus, Henson is offering a cross-sell “at a discount based on the state of the system”, but only when it “is determined that the component satisfies predefined conditions”, i.e. only when the user has selected Microsoft Windows 95 or 98.

Claims 35 and 36: Henson discloses a method as in Claim 33 above, and further discloses a limited quantity of the cross-sell product based on one or more component products selected by the user (column 8, lines 34-55). Henson gives an example of the system providing a warning message to the user when a motherboard will allow only three things to be added and the user attempts to select a fourth product.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (6,167,383).

Claim 37: Henson discloses a method for cross-selling products based on a system configuration, comprising:

- a. receiving user selection of one or more components of a configured system (Figures 3a-3c; column 4, lines 41-47; and column 6, lines 18-43);
- b. determining, based on the selected components, one or more cross-sell products that may be added to (i.e. compatible with) the system (column 10, lines 30-48);
- c. determining a discounted value for each of the cross-sell products (inherent);
- d. providing to the user one or more indications (i.e. a list of the cross-sell product or products) along with the determined discount price (Figure 3a);
- e. receiving a user selection of a cross-sell product and adding it to the system (Figures 3a-3c); and
- f. presenting a message to the user indicating a valid or invalid selection (column 5, lines 1-2; column 6, lines 39-43; column 7, lines 22-38 and 57-61).



While Henson does not explicitly disclose receiving a second configured system based on a previous order from the same user, it is disclosed that the user may be an individual, a business (small, medium, or large), or a government employee (Figure 8) and it is also disclosed the system asks if the user is a previous customer (Figure 7). The Examiner also notes that compatibility with legacy systems is always a main concern to businesses looking to upgrade or expand their existing systems. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Henson to check the compatibility of the component of the new system to each other, but also the compatibility of the components (and the whole system) with one or more previously ordered systems. One would have been motivated to do such a compatibility check between the systems in order to allow businesses to integrate the new system with their legacy systems. Additionally, if it is determined that the two systems are not compatible (e.g. old Mac system vs new PC system), such a determination may provide the opportunity for the merchant to present an offer to the user for additional software or hardware, such as a MAC to PAC converter.

Claim 38: Henson discloses a method as in Claim 37 above, and further discloses the discount (free McAfee VirusScan software) is based on the first configured system (Figure 3a).

Claims 39 and 40: Henson discloses a method as in Claim 37 above, but does not explicitly disclose that the discount is based on the second or both of the systems. However, as discussed above, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Henson to select a cross-sell (discount) based not only on the currently selected system (first system), but also based in whole or in part on any previously ordered system (i.e. legacy system) of the user. One would have been motivated to select the cross-sell based at least in part on the user's legacy system in order to allow easier updates of the system, eliminate the need to maintain several similar programs (e.g. using both McAfee and Norton anti-virus software within the business' system), etc.

Claim 41: Henson discloses a method as in Claim 37 above, and further discloses the discount is the entire price of the product, i.e. a free product (Figure 3a).

Claims 42 and 43: Henson discloses a method as in Claim 37 above, and further discloses a limited quantity of the cross-sell product based on one or more component products selected by the user (column 8, lines 34-55). Henson gives an example of the system providing a warning message to the user when a motherboard will allow only three things to be added and the user attempts to select a fourth product.

***Response to Arguments***

6. The Applicant argued in page 12 Henson does not disclose “each and every element as set forth in the clam”. For example, Henson does not disclose “ a computer-implemented method of cross-selling product based on a system for sale to a customer that includes “presenting the one or more cross-sell products to the user, wherein each of the one or more cross-sell product presented to the user is offered at a discount based on sate of system, and wherein each of the one or more cross-sell products presented to the user is determined to be compatible with the state of the system”.

However, the examiner respectfully disagree with the Applicant because Henson teaches presenting the one or more cross-sell products to the user (*Col. 6, 39-43, where "option recommended to be selected" reads on one or more cross-sell products, Col. 7, lines 22-41, which teaches merchandizing recommendation are provided to customer, and Col. 9, line 40- Col. 10, line 18, and where "cross-sell opportunities are made available in shopping cart" reads on presenting one or more cross-sell product to the user).*

The Applicant further argued in page 13 that there is no indication that the McAfee software is being offered “at a discount based on the stat of the system,” the prior art is not sufficient to establish the inherency of that result or characteristics and the Applicant concluded that Henson does not inherently teaches software offered at a discount based on the state of the system.

The examiner answers that the Applicant’s specification page 10 paragraph [0039] lines 13-15 indicates that “in any case, the cross-sell products may be offered at

a discount price (or be entirely free), but only when purchased along with another specific product. Therefore, the Applicant's "discount" means simply "entirely free. Therefore, according to the applicant specification of paragraph [0039], lines 13-15, Henson is not missing the following limitation: "wherein each of the one or more cross-sell product presented to the user is offered at a discount based on state of system" (*Fig. 3A, which teaches offering McAfee Virus Scan 3.1 at no additional charge for selecting Microsoft Window 95 or 98 reads on user is offered at a discount or entirely free for selecting one or more cross-sell product*) and wherein each of the one or more cross-sell products presented to the user is determined to be compatible with the state of the system (*Fig. 3A, which teaches determining products presented to user is compatible with the system*).

The Applicant further argues in pages 14 and 15 that Henson does not teach each of the one or more cross-sell products presented to the user is determined to be compatible with the state of the system. The Applicant argued that Henson is entirely silent with regarding to the selection box show in Figure 3A. The Applicant further argued Henson does not teach the determining compatibility with the state of the system. However, the examiner respectfully disagrees with the applicant because Henson teaches in (Fig. 3A) selection may require changes to other configuration choice and (Fig. 3C) teaches compatibility check with other system options. Henson is not silent with regarding check box; it is given a choice to check the box if a user wishes to add the product to the cart by checking the box. Additionally, Henson teaches determining, based on the user selection of one or more component product (*Col. 4,*

*lines 41-47 and Col. 6, lines 18-43, which teach customer selects one or more product that customer interested in) a discount value for each of one or more cross-sell products” (inherent). Because Henson disclose the presence of items (products) in the cart with “pricing from two different discounted pricing list”, which reads on product a discount value (Col. 10, lines 30-48), additionally, Henson teaches a particular type of customer set in which discount pricing is private and the information is password protected (Col. 14, lines 33-41)*

The Applicant argued in page 17 that Henson fails to teach “an earlier system order placed by the customer is then retrieved or that there any sort of checking for cross-sell product that are compatible with both current system order and the earlier system order.” The Applicant argues that Henson does not disclose the earlier system order placed by the customer is then retrieved or that there is any sort of checking for cross-sell product that are compatible with both a current system order. The Applicant further argues that the office has not provided a prim facie case of obviousness are require since Henson does not disclose any sort of storage of earlier system orders at all, or of any need for compatibility across orders.

The Examiner notes that Henson does not explicitly disclose an earlier system order placed by the customer is then retrieved or that there any sort of checking for cross-sell product that are compatible with both current system order and the earlier system order. However, Henson disclosed that the user may be an individual, a business (small, medium or large), or government agency (Fig. 8), the system ask if the user is a previous customer (Fig. 7) and option that require a check for compatibility

(Fig. 3C). The examiner also notes that compatibility with a legacy system is always a main concern to a business looking to upgrade its existing systems. Therefore, it would have been obvious to the one ordinary skill in the art at the time of the invitation was made for Henson to check the compatibility of earlier system orders, also the compatibility of the components (and the whole system) with one or more previously ordered systems. One would have been motivated to do such a compatibility check between the systems in order to allow businesses to integrate the new system with their legacy systems. Additionally, if it is determined that the two systems are not compatible (e.g. old Mac system vs new PC system), such a determination may provide the opportunity for the merchant to present an offer to the user for additional software or hardware, such as a MAC to PAC converter.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.D.  
April 6, 2009

/James W Myhre/  
Primary Examiner, Art Unit 3688